

HP Docket No. 200301153-1

REMARKS

This Amendment modifies the Request for Continued Examination (RCE) filed herewith.

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 1, 3-4, 6, and 20-22 have been amended, claims 7-9, 12, 15-19, 23-25, 27, 29, and 31 have been cancelled without prejudice, and new claims 32-36 have been added. Support for any claim amendments and new claims is found throughout the specification, claims, and drawings as originally filed, and no new matter has been added. Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Rejections**Rejection Under 35USC §103**

Claims 1, 3-4, 6, 13, and 20-22 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,917,615 to Reifman et al. ("Reifman") in view of U.S. patent application publication 2002/0083121 to Chang et al. ("Chang"). Applicants respectfully traverse the rejection and request reconsideration based on the amendment to independent claims 1 and 20 and features in the claims which are neither disclosed nor suggested in the cited references, taken either alone or in combination.

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under §103 to establish a *prima facie* case of obviousness by showing some objective

HP Docket No. 200301153-1

teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See In re Fine, 837 F.2d 1071, 5 U.S.P.O.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

More recently, the Supreme Court, quoting In Re Kahn, 441 F.3d, 977, 988 (CA Fed. 2006), has clarified that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” Teleflex Inc. v. KSR Int'l Co., 82 USPQ2d 1385, 1396 (S.Ct. 2007).

The rejection of independent claim 1, and its dependent claims 3-4, 6, and 13, is respectfully traversed for at least the following reasons. Claim 1 recites:

“1. (Currently amended) A method for providing recipient-end security for transmitted data, the method comprising:

identifying data to be transmitted to a data receiving device of a recipient;
configuring the identified data on a data transmitting device so as to add an executable to the data that, when executed on the data receiving device, verifies that one or both of the recipient and the data receiving device are authorized to access the transmitted data;
transmitting the identified data and the executable from the data transmitting device to the data receiving device;
the executable executing on the data receiving device and determining if the transmitted data may be accessed by the recipient; and
the executable denying access to the transmitted data if it is determined that the

HP Docket No. 200301153-1

transmitted data may not be accessed.” (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations.

Neither the Reifman nor the Chang reference disclose or suggest an executable that, when transmitted from a data sending device and executed on a data receiving device, verifies that one or both of the recipient and the data receiving device are authorized to access the transmitted data. Applicants note that a similar recitation was previously presented in now-canceled claim 27, but that limitation was not addressed in the Office Action.

Therefore, for the reasons discussed herein, the applied references, alone or in combination, do not teach or suggest all of Applicants' claim limitations, and thus the rejection is improper at least for this reason and should be withdrawn.

Independent claim 20 (currently amended) recites limitations similar to those of claim 1, discussed above.

Claim 20 recites:

“20. (Currently amended) A data transmitting device comprising:
an executable program configured to be transmitted along with identified data to a data receiving device and to execute on the data receiving device when a recipient attempts to access the identified data, the executable program further being configured to verify that one or both of the recipient and the data receiving device are authorized to access the identified data; and
sender-end logic configured to add the executable program to the identified data and transmit the executable program and the identified data to the data receiving device.” (emphasis added)

For similar reasons as explained heretofore with regard to claim 1, the features of the present invention are not taught or suggested by the cited references in that the features of the executable program are neither taught nor suggested by the references in combination.

Therefore, the rejection of independent claim 20, and its dependent claims 21-22, is improper at least for that reason and should be withdrawn.

RECEIVED
CENTRAL FAX CENTER

SEP 04 2008

HP Docket No. 200301153-1

Conclusion

Attorney for Applicants has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

Page 9 of 10

IIP Docket No. 200301153-1

**AUTHORIZATION TO PAY AND PETITION
FOR THE ACCEPTANCE OF ANY NECESSARY FEES**

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



Robert C. Sismilich
Reg. No. 41,314
Attorney for Applicant(s)
Telephone: (941) 677-6015

Date: 9/4/08

Hewlett-Packard Company
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400

Page 10 of 10